



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

| | | |
|------------------------------|---|------------------------|
| In re Patent Application of |) | |
| Takeshi Morikawa et al. |) | Group Art Unit: 2624 |
| Application No.: 09/679,070 |) | Examiner: King Y. Poon |
| Filed: October 5, 2000 |) | Confirmation No.: 7739 |
| For: NETWORK PRINTING SYSTEM |) | |

RECEIVED
NOV 02 2004
Technology Center **2600**

RESPONSE

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The Examiner is thanked for the careful examination of the application, and for the indication of allowable subject matter. However, in view of the remarks that follow, the Examiner is respectfully requested to reconsider and withdraw the outstanding rejection.

Claims 1, 2, 7-21, 14 and 15 have been rejected under 35 U.S.C. §102(b) as being allegedly anticipated by U.S. Patent No. 5,129,639, hereinafter *DeHority*.

Independent claim 1 defines a printing system including a printer that operates in either a first operating environment and a second operating environment that is different from the first operating environment. The printing system includes, among other elements, a controller that, when a parameter determiner determines that a printing parameter is prohibited and the operating environment determining means detects that the environment is the first operating environment, prohibits processing of the print job using the print parameter prohibited.

In making the rejection, the Examiner alleges that *DeHority* discloses a printing system that operates in either a first or a second operating environment. As evidence thereof, the Examiner refers to column 3, lines 40-45, wherein two different modes are described. The first disclosed mode is the "substitute" mode which enables the printing system to substitute parameters if the requested parameter is not available. The second mode is the "notify" mode which does not automatically make substitutions, but instead notifies the operator if a requested parameter is not available. Thus, the two modes identified by the Examiner as "operating environments" are merely operating modes that are selected and controlled by the operator.

In contrast to the *DeHority* reference, the subject matter of claim 1 refers to operating environments not operating modes. The American Heritage Dictionary defines "environment" as "the circumstances or conditions that surround one; surroundings" and "the totality of circumstances surrounding an organism or a group of organisms". Thus, by definition, the operating environment is external, not internal to the printing system. This definition is consistent with the specification of the present application which associates the operating environment with the presence of lack thereof of a manager or person who can replace paper or toner (page 1, line 25 through page 2, line 5) or it is associated with a time period (page 26, lines 16-22). Thus, the description in the specification concerning operating environments is consistent with the dictionary definition which indicates that the operating environment is a circumstance or condition that surrounds or is external to the printing system, not an operating mode or condition that is internal to the printing system.

Accordingly, Applicants submit that when the terms of the claims are properly construed, *DeHority* does not teach or suggest a controller that functions based on different operating environments, as set forth in claim 1.

Accordingly, claim 1 is clearly patentable over *DeHority*.

Claims 2 and 7-12 depend from claim 1, and are thus also patentable over *DeHority* at least for the reasons set forth above with respect to claim 1.

Claim 14 defines a print job management method that also defines the printing system in terms of first and second operating environments and includes the step of prohibiting processing of a print job using the print parameter prohibited when the determining step determines that a printing parameter is prohibited and the detecting step detects that the environment is the first operating environment. As set forth above with regard to claim 1, claim 14 defines a method that is dependent upon the particular operating environment. In view of the fact that the definition accorded to operating environment by the Examiner is incorrect, Applicants submit that *DeHority* does not teach or suggest the print job management method of claim 14. Specifically, *DeHority* does not teach or suggest detecting whether the printer operating environment is the first operating environment or the second operating environment and it further does not teach or suggest the prohibiting step that is based on detected operating environment.

As set forth above, a printing mode set by the user internally to the printing system is not an operating environment as that term is used in the present application.

Accordingly, claim 14 is also patentable over the cited prior art reference, *DeHority*.

Claim 15 defines a printing system that includes, among other elements, an operating environment detector and a controller that executes modes based on the determination by the operating environment detector. However, in view of the comments set forth above concerning the Examiner's interpretation of the term "operating environment", Applicants submit that *DeHority* does not teach or suggest the claimed combination that includes the operating environment detector and the controller that operates based on such detected operating environments.

Accordingly, claim 15 is also patentable over *DeHority*.

Claims 3, 4, and 5 have been rejected under 35 U.S.C. §103(a) as being unpatentable over *DeHority* as applied to claim 1, and further in view of U.S. Patent No. 6,160,269, hereinafter *Tang*. However, *Tang* does not overcome the deficiency of the rejection of claim 1 as discussed above. Accordingly, the Examiner is respectfully requested to reconsider and withdraw the rejection of claims 3, 4 and 5 based on *DeHority* and *Tang*.

Claim 13 has been rejected under 35 U.S.C. §103(a) as being unpatentable over *DeHority* as applied to claim 1 above, and further in view of U.S. Patent No. 5,467,434, hereinafter *Hower*. However, like *Tang*, *Hower* does not overcome the deficiency of the rejection of claim 1 based on *DeHority*. Accordingly, claim 13 is also patentable over the applied prior art at least for the reasons set forth above with respect to claim 1.


In view of the foregoing remarks, the Examiner is respectfully urged to reconsider and withdraw the outstanding rejection.

In the event that there are any questions concerning this response, or the application in general, the Examiner is respectfully urged to telephone the undersigned attorney so that prosecution of the application may be expedited.

Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

Date: 11-1-2004

By: 
William C. Rowland
Registration No. 30,888

P.O. Box 1404
Alexandria, Virginia 22313-1404
(703) 836-6620